

REMARKS

Claims 1-23 are pending.

I. The Restriction Requirement and Applicant's Provisional Election

The Examiner required restriction, under 35 U.S.C. §§ 121, 372, between Groups I to X as these inventions or groups of inventions allegedly are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In response, Applicants hereby provisionally elect, with traverse, Group II, claims 3-6, 8, 10, and 11, drawn to a DNA encoding a human transmembrane polypeptide, recombinant methods of making the polypeptide and host cells comprising the polynucleotide.

The Examiner also stated that one SEQ ID NO must be selected to be considered responsive. Applicants hereby provisionally elect, with traverse, the polynucleotide of sequence SEQ ID NO: 57 and nucleic acids encoding the polypeptide of SEQ ID NO: 28.

II. The Polypeptides Of Group I And The Polynucleotides Of Group II Exhibit Corresponding Special Technical Features

Applicants traverse the restriction requirement because the unity of invention standard must be applied in national stage applications. Section 1850 of the Manual of Patent Examining Procedure (original 8th edition, published August, 2001) (hereinafter "MPEP") provides that

when the Office considers international applications . . . during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111

. . .

In applying PCT Rule 13.2 to . . . national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in

the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2

MPEP at page 1800-60 to -61.

MPEP section 1893.03(d) reiterates the Examiner's obligation to apply the Unity of Invention standard PCT Rule 13.2 instead of U.S. restriction/election of species practice:

Examiners are reminded that unity of invention (not restriction) practice is applicable . . . in national stage (filed under 35 U.S.C. 371) applications.

Id. at page 1800-149, col. 1.

Indeed, according to Example 17, Part 2 of Annex B to the PCT Administrative Instructions, the Examiner is obliged to find that "the protein and the DNA sequence exhibit corresponding special technical features" and that, therefore, there is no lack of unity between claims directed to a protein "X" and the DNA sequence that encodes protein "X."

Thus, in the present case, unity of invention does exist at least as between claims 1-2, and 15 of Group I, which encompass the polypeptides depicted in SEQ ID NO: 28, and claims 3-6, 8, 10, and 11 of Group II, which encompass the polynucleotides which encode those polypeptides, the polynucleotide of SEQ ID NO: 57, recombinant methods of making the polypeptide and host cells comprising the polypeptide. Therefore, Applicants respectfully request that the Examiner withdraw the Restriction Requirement at least as to claims 1-6, 8, 10, 11, and 15 of Groups I and II, and examine those claims in a single application.

III. Rejoinder of Method Claims

Additionally, Applicants note that once the elected claims are found allowable, the method claims must be rejoined to the extent that the claims incorporate "all the limitations of [a] allowable product claim." See MPEP § 821.04.

IV. Conclusion

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

If there are any fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 19-0741. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should be charged to our Deposit Account.

Respectfully submitted,

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